

REMARKS

Claims 29-54 are pending in the application.

Claims 51-54 are rejected.

Claims 29-50 are withdrawn.

Claim 51 is amended. Entry, reconsideration and allowance of claims 51-54 is respectfully requested in light of the accompanying Request for Continued Examination and in view of the following remarks:

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osaka (U.S. Patent No. 5,628,054) (Osaka hereinafter) and in view of Rasmussen et al (U.S. Patent Publication No. 2003/0167244) (Rasmussen hereinafter) as evidenced by Wehmeyer are maintained. This rejection is not applicable to the claims.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach all limitations of any rejected claim.

Claim 51 includes, in part, "wherein the battery subassemblies are mechanically and electrically separable to be shipped such that the additional shipping fee that would be incurred due to the battery assembly watt-hour rating is avoided." The Office Action asserts that the nickel metal hydride battery (14a) corresponds to the first battery subassembly and that the lithium ion battery (14b) corresponds to the second battery subassembly. Applicants

respectfully disagree. As can be seen at Figs. 1-4 of Osaka, Osaka does not teach that the nickel metal hydride battery (14a) and the lithium ion battery (14b) are mechanically and electrically separable to be shipped such that an additional shipping fee that would be incurred due to the battery assembly watt-hour rating is avoided.

Additionally, Osaka does not teach that the battery assembly includes a battery assembly watt-hour rating high enough to invoke an additional shipping fee, that the nickel metal hydride battery (14a) includes a first battery subassembly watt-hour rating that is less than the battery assembly watt-hour rating and is low enough to avoid invoking the additional shipping fee, or that the lithium ion battery (14b) includes a second battery subassembly watt-hour rating that is less than the battery assembly watt-hour rating and is low enough to avoid invoking the additional shipping fee.

Wehmeyer does nothing to overcome the deficiencies of Osaka. Wehmeyer teaches that the energy density of each individual battery depends on the design of the individual battery, and that the energy density of the different types of batteries can change from one design to the next. According to Wehmeyer, an increase of specific energy (watt-hours per unit weight) or energy density (watt-hours per unit volume) "can be attributed to a decrease in the weight and volume of the passive components of the cell." Page 201. As such, the watt-hour rating of a battery depends on the battery's design and cannot be determined based solely on the battery's weight.

As discussed above, Osaka and Wehmeyer fail to teach key limitations of independent claim 51. Rasmussen teaches nothing to overcome these deficiencies. Rasmussen teaches a system for optimizing weight based delivery fees for packaged advertising material. Paragraphs [0010] and [0011]. According to Rasmussen, "[t]his optimization is performed in light of the incremental nature of U.S. Postal and delivery service or private carrier delivery service weight breakpoints." Paragraph [0011]. If the teachings of Wehmeyer were combined with the teachings of Rasmussen, this would teach, at best, a system for optimizing weight based delivery fees for batteries based on the delivery service weight breakpoints based on the incremental characteristics of delivery rates. This does not teach battery subassemblies that are mechanically and electrically separable to be shipped such that an additional shipping fee that would be incurred due to the battery assembly watt-hour rating is avoided.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima*

facie case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable to claim 51, and those claims that depend therefrom.

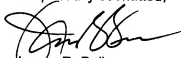
Therefore, independent claim 51 and its respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 51-54 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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